

S/N: 10/661,018

Atty Dkt No. GP-303369/GM0383PUS

### REMARKS

The following remarks are intended to be fully responsive to the Office Action mailed March 22, 2005.

Claims 1-5 and 16-19 are pending. Claims 6-15 are withdrawn from consideration. Claim 5 is objected to. Claims 1-2, 4-5, and 16-18 are finally rejected under 35 USC § 102(b) as being anticipated by Scott et al. (6,003,923). Claims 1, 3, and 19 are finally rejected under 35 USC § 102(b) as being anticipated by Nelson et al. (4,126,349). Claim 19 is finally rejected under 35 USC § 102(b) as being anticipated by Lyall (5,000,502). Applicant has amended claims 1, 5, 16, 17, 18, and 19. Applicant has cancelled claim 3.

#### Claim Objections

Claim 5 is objected to because "open" should be "opening." Applicant has amended claim 5 accordingly.

#### Claim Rejections – 35 U.S.C. § 102(b)

Claims 1-2, 4-5, and 16-18 are rejected under 35 USC §102(b) as being anticipated by Scott et al.

For a rejection to be proper under 35 U.S.C. § 102, every element and limitation found in the rejected claim must be found in the § 102 reference. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See MPEP §2131. Scott et al. do not disclose each of the elements and limitations found in claims 1-2, 4-5, and 16-18.

Claim 1 has been amended to recite a pickup truck having "a sidewall at least partially defining a pickup truck cargo box, ... with an elongated opening formed in the sidewall between the cab and the rearward portion; ... wherein said opening is upwardly open." It should be noted that the limitation added to claim 1 is substantially

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similar to a limitation of cancelled claim 3, which is not rejected under 35 USC § 102(b) as being anticipated by Scott et al. Indeed, Scott et al. clearly do not teach an opening being “upwardly open.” Rather, as shown in Figure 3 of Scott, et al., “[t]he bed rail 4 ... protrudes inwardly over portion 4a of the enclosed storage space 7R.” Scott et al., column 7, lines 29-31.

Accordingly, amended claim 1 recites elements and limitations that are not disclosed, either expressly or inherently, by Scott et al. Claims 2, 4, and 5 ultimately depend from claim 1 and therefore are not anticipated by Scott et al. for at least the same reasons that claim 1 is not anticipated by Scott et al.

Claim 16 has been amended to recite a method including, *inter alia*, “possessing a pickup truck ... including a cab and a first sidewall ... with a first elongated opening formed in the first sidewall between the cab and the first rearward portion, said first elongated opening being upwardly open ... ; and attaching a first sidewall module to the pickup truck such that the first sidewall module is at least partially within the first elongated opening.” (underlining added for emphasis). As noted above, Scott et al. does not disclose an elongated opening being upwardly open. Accordingly, amended claim 16 is not anticipated by Scott et al. Claims 17 and 18 depend from claim 16, and therefore are not anticipated by Scott et al. for at least the same reasons that claim 16 is not anticipated by Scott et al.

Claim 18 has been amended to correct an informality. Furthermore, claim 18 recites “removing a second sidewall module from the first elongated opening prior to said attaching the first sidewall module, the second sidewall module being differently-structured and having a different functionality from the first sidewall module.” (underlining added for emphasis). In rejecting claims 16-18, the Examiner states that “Scott et al. inherently disclose a method of adding or altering pickup truck sidewall functionality ... comprising: possessing a pickup truck, ... and attaching a first sidewall module to the pickup truck ... ; [and] removing a second sidewall module from the first elongated opening prior to the step of attaching the first sidewall module, the second sidewall module being differently-structured and having a different functionality from the first sidewall module.” The Examiner rejected claim 18 in a conclusory manner, and does not cite text or reference numbers from Scott et al. to support the rejection.

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Applicant respectfully submits that Scott et al. does not disclose, either expressly or inherently, the steps of removing a sidewall module from an elongated opening, and subsequently attaching another, structurally different sidewall module in the elongated opening, as recited by claims 16 and 18. Applicant respectfully requests that the Examiner cite text that expressly teaches the limitations of claim 18, or provide a basis in fact or technical reasoning to show that the limitations of claim 18 are necessarily present in Scott et al., as required for a finding of inherency. See MPEP § 2112.

Claims 1, 3, and 19 are rejected as being anticipated by Nelson et al. The Examiner states that Nelson et al. "disclose a pickup truck comprising ... a sidewall at least partially defining a pickup truck cargo box, the sidewall having a forward portion and a rearward portion with an elongated opening (between 18a and 18e, Figure 6) formed in the sidewall ... and at least one fastening element 15, 16, 27 ... for mounting any one of a plurality of differently-configured sidewall modules 18c at least partially within the elongated opening."

Claim 1 has been amended to further recite a limitation substantially similar to claim 3, namely that "said opening is upwardly open." In rejecting claim 3, the Examiner states that "the opening is uncovered and upwardly open when module 18c is removed" (underlining added for emphasis). However, there is no teaching in Nelson et al. that the module 18c is removable without also removing modules 18a and 18e. Nelson et al. describe the sidewall as being formed by modules 18a, 18c, and 18e: "the modules ... define the entire body side walls 11 and 12 from top to bottom." Nelson et al., column 4, lines 53-55. (underlining added for emphasis). Furthermore, Nelson et al. state that "In each of the truck body side walls, one of the ... modules has a wheel well formed in the lower portion thereof." Nelson et al., column 2, lines 42-44. Module 18c is one of the modules that "has a wheel well formed in the lower portion thereof." See Nelson et al., column 5, lines 6-7. Accordingly, if each of the truck body side walls has a module with a wheel well formed therein, and 18c is the module that forms a wheel well, then module 18c will not be removed to form an opening that is upwardly open.

Indeed, the manner in which the modules 18a, 18c, and 18e of Nelson et al. are attached to the truck T clearly shows that modules 18a and 18c cannot be attached to the truck without module 18e:

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The end walls 24 of adjacent modules 18 lie flush against each other and are secured together by fasteners such as bolts 25 extending through the plurality of aligned apertures 26 in the end walls 24. ... The recesses 27 in adjoining end walls 24 are located in confronting relation with each other as to define a socket receiving and capturing the end portion of the adjacent joist. ... In addition, the joists 15 are affixed to the end walls 24 at the recesses 27 by clamping fasteners such as bolts 30.

Nelson et al., column 4, lines 24-27, lines 35-38, and lines 49-50. With reference to Figure 8 of Nelson et al., the modules are attached to one another by fasteners 25 that extend through apertures 26 in the end walls 24 of adjacent modules, thereby to form side wall 11. The modules are then connected to the truck at joist 15 via bolts 30, each of the bolts 30 extending through the end walls 24 of adjacent modules 18a, 18c. Thus, module 18c cannot be removed without also removing modules 18a and 18e because the bolts 30 that connect module 18c to the truck also connect modules 18a and 18e to the truck.

In summary, Nelson et al. teach that the sidewall 11 is formed entirely by modules 18a, 18c, and 18e. Sidewall 11 includes a module defining a wheel well, which is module 18c. The modules are connected to one another, and are connected to the truck in a manner that makes removal of module 18c impossible without also removing modules 18a and 18e. Thus, module 18c is not removable without removing the entire sidewall, and therefore the Examiner's statements that Nelson et al. disclose a "sidewall having a forward portion and a rearward portion with an elongated opening (between 18a and 18e, Figure 6) formed in the sidewall," and that "the opening is uncovered and upwardly open when module 18c is removed" are inconsistent with the teachings of Nelson et al.

Moreover, there is no teaching in Nelson et al. that "a plurality of differently-configured sidewall modules" are mountable at the "at least one fastening element," as recited by claim 1. Rather, Nelson et al. only teach module 18c being mountable between elements 18a and 18e. Accordingly, claim 1 is not anticipated by Nelson et al.

Accordingly, claim 1 is not anticipated by Nelson et al. Claim 19 recites "a sidewall ... having a forward portion and a rearward portion with an elongated

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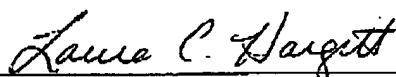
opening formed in the sidewall between the forward and rearward portions, the opening being uncovered and upwardly open." (underlining added for emphasis). Accordingly, the analysis presented for claim 1 also applies to claim 19, and claim 19 is not anticipated by Nelson et al.

Claim 19 is also rejected under 35 U.S.C. § 102(b) as being anticipated by Lyall. The Examiner states that "[w]ith regard to the 'pickup truck' recitation in the preamble of the claim, this language is not believed to limit the claim." Applicant amended claim 19 to recite that the sidewall is "at least partially defining a pickup truck cargo box." The body of claim 19 now recites the limitation that the sidewall at least partially defines a pickup truck cargo box, and Lyall clearly does not teach a pickup truck cargo box. Accordingly, the rejection of claim 19 is believed to be overcome.

### CONCLUSION

This Amendment is believed to be fully responsive to the Office Action mailed March 22, 2005. The remarks in support of the amended claim and the rejected claims are believed to place all claims in the application in condition for allowance, which action is respectfully requested.

Respectfully submitted,



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